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10/686,425	10/15/2003	Stephen J. Anderson	13325-005001	7292
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EXAMINER REFAI, RAMSEY				
ART UNIT 3627		PAPER NUMBER		
NOTIFICATION DATE 05/27/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

10/686,425

Applicant(s)

ANDERSON ET AL.

Examiner

Ramsey Refai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-46 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 03/02/09
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Responsive to Amendment filed March 2, 2009. Claims 1, 2, 9, 13, 17, 21, 23, 28, 32, 38, and 43 have been amended. **Claims 47-67 were canceled. Claims 1-46 remain pending.**

Response to Arguments

1. Applicant's arguments have been fully considered but they are not persuasive.

- In the remarks, the Applicant argues with substance:

Argument. *Regarding the 112 rejections, the claims features identified in the Office action have proper antecedent basis and the claims satisfy the requirements of 112 2nd.*

In response, the Examiner respectfully disagrees and asserts that the claims are indefinite as follows:

Regarding claim 2: the limitations "a request" and "information" lack proper antecedent basis since both terms are recited in parent claim 1. Proper antecedence needs to be shown by amending these terms to include either "the" or "said" before the terms in question. If these limitations are different than what is being claimed in claim 1 then an amendment to claim 2 is needed (i.e. a second request, a second information).

Regarding claim 7: the limitation "information" lacks proper antecedent basis since this term is recited in parent claim 1. Proper antecedence needs to be shown by amending this term to include either "the" or "said" before the term in question. If this limitation is different than what is being claimed in claim 1 then an amendment to claim 7 is needed (i.e. a second information).

Regarding claim 9: the limitation "information" lacks proper antecedent basis since this term is recited in parent claim 1. Proper antecedence needs to be shown by amending this term

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to include either "*the*" or "*said*" before the term in question. If this limitation is different than what is being claimed in claim 1 then an amendment to claim 9 is needed (i.e. *a second information*).

Regarding claim 10: the limitation "*information*" lacks proper antecedent basis since this term is recited in parent claim 1. Proper antecedence needs to be shown by amending this term to include either "*the*" or "*said*" before the term in question. If this limitation is different than what is being claimed in claim 1 then an amendment to claim 10 is needed (i.e. *a second information*).

Regarding claim 11: the limitations "*a request*", "*information*" lack proper antecedent basis since these terms are recited in parent claim 1. Proper antecedence needs to be shown by amending these terms to include either "*the*" or "*said*" before the terms in question. If these limitations are different than what is being claimed in claim 1 then an amendment to claim 10 is needed (i.e. *a second request, a second information*).

Regarding claim 12: the limitation "*information*" lacks proper antecedent basis since this term is recited in parent claim 1. Proper antecedence needs to be shown by amending this term to include either "*the*" or "*said*" before the term in question. If this limitation is different than what is being claimed in claim 1 then an amendment to claim 12 is needed (i.e. *a second information*).

Regarding claim 13: the limitation "*information*" lacks proper antecedent basis since this term is recited in parent claim 1. Proper antecedence needs to be shown by amending this term to include either "*the*" or "*said*" before the term in question. If this limitation is different than what is being claimed in claim 1 then an amendment to claim 13 is needed (i.e. *a second information*).

Regarding claim 14: the limitation "*a user selection*" lacks proper antecedent basis since this term is recited in parent claims 1 and 11. Proper antecedence needs to be shown by

amending this term to include either "*the*" or "*said*" before the term in question. If this limitation is different than what is being claimed in claims 1 and 11 then an amendment to claim 14 is needed (i.e. a second user selection).

Regarding claim 15: the limitation "*information*" lacks proper antecedent basis since this term is recited in parent claim 1. Proper antecedence needs to be shown by amending this term to include either "*the*" or "*said*" before the term in question. If this limitation is different than what is being claimed in claim 1 then an amendment to claim 15 is needed (i.e. a second information).

Regarding claim 16: the limitations "*information*", "*a user*", lack proper antecedent basis since these terms are recited in parent claim 1 and 11. Proper antecedence needs to be shown by amending these terms to include either "*the*" or "*said*" before the terms in question. If these limitations are different than what is being claimed in claims 1 and 11 then an amendment to claim 10 is needed (i.e. a second information, a second user).

Claims 17-46 contain similar 112 issues. The Applicant is requested to carefully review all pending claims to ensure that they comply with the requirement of 112 2nd paragraph.

- Applicant's arguments in view of the prior art have been considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 10/15/03, 06/20/05, 12/01/06, and 07/18/07 are being considered by the examiner.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2: the limitations "a request", "information" lack proper antecedent basis;

Claim 7: the limitation "information" lacks proper antecedent basis;

Claim 9: the limitations "information", lack proper antecedent basis;

Claim 10: the limitations "information", lack proper antecedent basis;

Claim 11: the limitations "a request", "information" lack proper antecedent basis;

Claim 12: the limitations "the information", lack proper antecedent basis;

Claim 13: the limitations "the information", lack proper antecedent basis;

Claim 14: the limitation "a user selection" lacks proper antecedent basis;

Claim 15: the limitations "the information", lack proper antecedent basis;

Claim 16: the limitation "information", "a user", lack proper antecedent basis.

Claims 17-46 contain similar 112 issues.

The Applicant is requested to carefully review all pending claims to ensure that they comply with the requirement of 112 2nd paragraph.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Frank et al (US Patent 7,117,199) in view of LeBrun et al (US 5,191,525).

6. As per claim 1, Frank et al teach a method comprising:

presenting an interactive, graphical depiction of a form through a computer network and allowing for selection of a desired location on the form **(at least column 1, lines 34-41; map);**

receiving a request for information relating to a location on the form selected by a user, the selection and the request being made through interaction with the graphical depiction of the form **(at least column 1, lines 34-41, column 6, lines 18-29; user query via map, also by clicking on map);** and

delivering information to the user through the network in response to the request wherein the delivered information includes at least one of the following relating to the selected form

location: planning information, consulting materials, research, and compliance information (**at least column 1, lines 20-27, 41-67; documents retrieved relating to user query**).

Frank et al teach a graphical depiction of a form such as a map but fails to teach wherein the form *is a document with one or more areas for insertion of information*. However, LeBrun et al teach an image of a tax form (**see at least fig 6**). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to combine LeBrun et al with Frank et al because doing so would allow for information on a particular region of the tax form to be displayed.

7. As per claim 2, Frank et al further teach:

receiving a request for information relating to a second (**at least column 27, line 35-column 28, line 10; subsequent interactions**) selected location on the form selected by the user through another interaction by the user with the graphical depiction of the form (**at least column 1, lines 34-41; map**); and delivering additional information to the user through the network, wherein the additional information includes at least one of the following relating to the second selected form location: planning information, consulting materials, research or compliance information **least column 1, lines 20-27, 41-67; documents retrieved relating to user query**).

8. As per claim 3, Frank et al fails to teach wherein the form comprises *a tax form*.

However, LeBrun et al teach an image of a tax form (**see at least fig 6**). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to combine LeBrun et al with Frank et al because doing so would allow for information on a particular region of the tax form to be displayed.

9. As per claim 4, Frank et al teach wherein the selected form location corresponds to a section of the form identified by an alphanumeric designation **(at least column 6, line 40-45, column 7, line 3-7, column 8, lines 8-18)**.
10. As per claim 5, Frank et al teach retrieving, from a database, ideas that are linked to the selected form location; and delivering the ideas to the user through the network **(at least column 1, line 61-column 2, line 16; documents are ranked)**.
11. As per claim 6, Frank et al teach including providing to the user a list of hyperlinks for information from third-parties that relates to the selected form location **(at least column 1, lines 50-56)**.
12. As per claim 7, Frank et al teach wherein at least one of the hyperlinks provides access to pages that are pre-populated with information relating to the selected form location **(at least column 1, lines 50-56, column 5, line 59-column 6, line 10)**.
13. As per claim 8, Frank et al teach wherein at least one of the hyperlinks provides access to information from subscription-based services **(at least column 13, lines 6-16)**.
14. As per claim 9, Frank et al teach wherein at least one of the hyperlinks provides access to pages created based on a search of information contained in the ideas **(at least column 1, line 50-column 2, line 17, column 5, line 59-column 6, line 10)**.

15. As per claim 10, Frank et al teach receiving an indication of the user's selection of a hyperlink in the list; authenticating the user to a third-party site associated with the selected hyperlink in a manner that is transparent to the user; and providing to the user information relating to the selected form location, wherein the provided information is obtained from the third-party site **(at least column 13, lines 6-32, column 5, line 59-column 6, line 10)**.

16. As per claim 11, Frank et al teach presenting an interactive depiction of a map through the network and allowing for selection of a desired jurisdiction **(at least column 1, lines 34-41; map)**; receiving a request for information relating to a selected geographic location on the map in response to the user's interaction with the depiction of the map **(at least column 1, lines 34-41, column 6, lines 18-29; user query via map)**; and delivering additional information to the user through the network, wherein the additional information relates to the selected geographic location **(at least column 1, lines 20-27, 41-67; documents retrieved relating to user query)**.

17. As per claim 12, Frank et al fail to teach wherein the form comprises a *tax form*, and wherein the information relating to the selected form location and the additional information relating to the selected geographic location comprise *tax-related information*. However, in the same field of endeavor, LeBrun et al teach an image of a tax form **(see at least fig 6)**. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to combine LeBrun et al with Frank et al because doing so would allow for information on a particular region of the tax form to be displayed.

18. As per claim 13, Frank et al teach wherein the form relates to a specified subject, **(at least column 1, lines 20-67; documents retrieved relating to user query)** but fails to teach

wherein the information relating to the selected form location and the additional information relating to the selected geographic location comprise *one or more sources of law relating to the specified subject, the sources of law including at least one relevant statutes, regulations or legal decisions*. However, it would have been obvious to one of ordinary skill in the art to include this limitation in Frank et al as modified by LeBrun et al above because doing so would allow for tax regulations for a particular part of the tax form to be displayed.

19. As per claim 14, Frank et al teach wherein presenting the interactive map occurs in response to receiving a user selection from among a plurality of available interactive maps **(at least column 7, lines 30-62, column 6, lines 30-63)**.

20. As per claim 15, Frank et al teach wherein the form relates to a specified subject and wherein the interactive map comprises a plurality of geographic regions about which information relating to the specified subject may be obtained, the method including delivering to a user, through the network, information relating to the specified subject and associated with a particular geographic region selected by the user **(at least column 1, lines 34-56)**.

21. As per claim 16, Frank et al teach wherein the form relates to a specified subject and wherein the interactive map depicts a plurality of countries **(at least fig 2)** about which information relating to the specified subject may be obtained, the method including delivering to a user through the network information relating to the specified subject and associated with a particular country selected by the user **(at least column 1, lines 34-56, fig 2, column 6, lines 30-63)**.

22. As per claims 17-46, these claims contain similar limitations as claims 1-16 above and therefore are rejected under the same rationale.

Conclusion

Examiner's Note: The Examiner has cited specific citations in the reference(s) as applied to the claim(s) above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the Applicant, in preparing their response, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ramsey Refai
May 21, 2009
/Ramsey Refai/
Examiner, Art Unit 3627